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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,266

09/18/2006

Satoru Banzai

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21839 7590 05/21/2009
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
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EXAMINER

POCHAS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

05/21/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/593,266	Applicant(s) BANZAI, SATORU	
	Examiner Christopher Pochas	Art Unit 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/12/2007, 3/15/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Office Action

1) Applicant's election with traverse of Group I, claims 7-18 in the reply filed on 9/18/2006 is acknowledged. The traversal is on the ground(s) that the process limitations of pending claim 19 are also recited in pending claim 7. This is not found persuasive since claim 7 is a product by process claim and there is no prima facie reason to believe that the process of making distinguishes the product from what is already known in the art and as such the original reason for restriction (i.e. that the cosmetic stick of the pending claims is not novel and therefore does not make a significant contribution over the prior art) is maintained. .

The requirement is still deemed proper and is therefore made FINAL.

2) Claim 19 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/18/2006.

3) This application is a 371 of PCT/JP2005/002784 filed February 22nd, 2005 which claims priority to Japanese Application No. 2004-074665 filed March 16th, 2004. All priority documents have been received and are currently in compliance.

Non Final Rejection

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishihama et al., U.S. Patent 6358495, issued March 19th, 2002 as evidenced by Encarta® World English Dictionary [North American Edition] © & (P)2009.

Claims 7-18 The cosmetic stick of the pending claims has been described in U.S. Patent 6358495 (hereafter the 495 patent). Note that the determination of patentability of a product is based on the product itself, and not its method of production, and so the process described in pending claim 7 has not been considered in this rejection. Lines 37-39 of column 2 of the 495 patent disclose that the titanium silica complex of the title is a mesoporous material as per pending claim 7. Note that silica is a ceramic as per pending claim 8 and the titanium constitutes the metal of pending claim 9. The paragraph of line 51 column 9 discloses extender materials to be used with the titanium silica complex as per pending claim 7. Note that the extender material mica is disclosed in Formulation Example 4 of the 495 patent (column 12), and that this example also includes the mesoporous titanium-silica complex, and is a stick type cosmetic. Note that the pore ranges of pending claims 10-12 are not actually further limiting the product, because a mesopore is defined as a pore with a diameter of 2-50 nm (see definition in Encarta® World English Dictionary [North American Edition] © & (P)2009, attached with this office action). The paragraph of line 11 of column 10 of the 495 patent discloses an embodiment which is a

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cosmetic pencil as per pending claims 13-18. This cosmetic pencil is one of only 5 forms disclosed by the 495 patent and so one would immediately envisage a cosmetic pencil based on this disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pochas whose telephone number is (571)270-7722. The examiner can normally be reached on Monday to Friday 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CMP/

/Sharmila Gollamudi Landau/

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Supervisory Patent Examiner, Art Unit 1611